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EXAMINER

LIN, WEN TAI

ART UNIT PAPER NUMBER

2154

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047,837

Applicant(s)

HIMMEL ET AL.

Examiner

Wen-Tai Lin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-11 and 13-39 are presented for examination. Claim 12 has been canceled.
2. The statements made in paragraph #3-4 of the previous office action assuming that the server also uses browser to record destination addresses is withdrawn because Applicant's argument is persuasive.
3. Claims 1-36 are objected to because of inconsistency found in the claim language. That is the specification consistently indicates that the word "captor" refers to a person who uses a computer to surf the Internet, to interactively select displayed telephones, and to activate a program for automatically storing the telephone number in an electronic telephone directory [see, e.g., paragraphs 7-9 and 32-35]. However, the amended claim language at claim 1 lines 8-9; claim 21 lines 10-11 and claim 27 lines 10-11 indicates that the captor is "selected from a computer running the browser or a server hosting the Web page. Clarification and/or correction is required in response to this office action.
4. It is noted that claim 37 should have been marked as "currently amended".

Claim Rejections - 35 USC § 102

5. Claims 1-2, 5-10, 21-24, 26-28, 31-33, 35 and 37-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Rossmann et al.[U.S. 20040111669].

6. As to claims 1-2, Rossmann teaches the invention as claimed including: a method for sending a telephone number record into a communications terminal [e.g., 301, Fig.3] comprising:

recording in a web browser a destination address of the communications terminal having the electronic telephone directory [paragraph 85; e.g., recording the address of the telephone directory in a bookmark or the local file system];

capturing one or more telephone number records from a Web page [paragraphs 44-45, 60-63, 68 and 78; e.g., saving a captured telephone in a PIM or a telephone book, wherein the act of selecting one or more telephone numbers may be accomplished by invoking the related operations];

sending a message containing the one or more captured telephone number records from a captor to the destination address of the communications terminal [Abstract; note that in Rossmann's system either the browser of the communication terminal or the servers 308 or 316 of Fig.3 can be used for scanning the web page for information –see paragraph 85].

Art Unit: 2154

7. As to claims 5-6, Rossmann further teaches that the communications terminal is selected from a mobile telephone, a personal computer, a voice mail messaging service, a FAX machine, a handheld computer, a personal digital assistant or combinations thereof, wherein the communications terminal is selected from a device that can store and retrieve information and is connectable to a telephone network [e.g., 301, Fig.3 or 400, Fig.4].

8. As to claim 7, Rossmann further teaches that the destination address for the communications terminal is selected from a computer network address, an Internet address or a telephone number [e.g., paragraphs 15 and 33-34; i.e., inherently the wireless device must be provided with a network address or ID for communicating with other servers in the network].

9. As to claims 8-9, Rossmann further teaches that the one or more telephone number records comprises a telephone number and an alphanumeric identifier for the telephone number, wherein the telephone number record comprises parameters selected from a telephone number, a contact name, an address, a FAX number, an e-mail address, a hyperlink to a Web site, a business name, a business specialty, business hours or combinations thereof. [paragraph 68; i.e., a telephone number can be associated with the person's name and other attributes].

10. As to claim 10, Rossmann further teaches that the step of recording the destination address comprises:

a. selecting a menu function on the browser for recording the communications terminal's destination address;

b. specifying the destination address on an interactive display provided by the browser; and

c. saving the destination address within the browser program.

[note that steps a-c are inherent procedures for recording a communications terminal's destination address in a bookmark accessible by the browser].

11. As to claims 21-24, 26-28, 31-33, 35 and 37-39, since the features of these claims can also be found in claims 1-2, 5-7 and 9, they are rejected for the same reasons set forth in the rejection of claims 1-2, 5-7 and 9 above.

Claim Rejections - 35 USC § 103

12. Claims 3-4 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossmann et al.(hereafter "Rossmann")[U.S. 20040111669], as applied to claims 1-2, 5-12, 21-24, 26-28, 31-33, 35 and 37-39 above, further in view of Official Notice.

13. As to claim 3, Rossmann further teaches that the selected data type (such as telephones) contained in a web page can be extracted and stored in a telephone book via a set of user selected operations.

Rossmann does not specifically teach that the selected operations include searching the existing electronic telephone directory to see if the number to be entered already exist or not, and if it does, then notify the user of the existence.

However, Official Notice is taken that this additional feature is well known in the art. For example, a user is warned when an attempt to overwriting a record of a file is made. It would have been obvious to one of ordinary skill in the art at the time the invention was made to follow this conventional procedure to update Rossmann's telephone directory because the procedure ensures the integrity of the directory.

14. As to claim 4, Rossmann does not specifically teach how a telephone record in the telephone directory is updated (e.g., deleting, adding, or modifying a record).

However, Official Notice is taken that the listed feature is a typical procedure in the art of updating a database and as such it can be applied to updating a telephone directory.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to adopt the conventional database updating procedure in updating Rossmann's system/method because such procedure ensures the integrity of Rossmann's telephone directory.

15. As to claims 16 and 29-30, since the features of these claims can also be found in claims 1, 3-4 and 27, they are rejected for the same reasons set forth in the rejection of claims 1, 3-4 and 27 above.

16. Claims 11, 13-15, 17-20, 25, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossmann et al. [U.S. 20040111669], as applied to claims 1-11, 21-24, 26-33, 35 and 37-39 above.

17. As to claims 13-14, Rossmann further teaches that the telephone number record comprises a telephone number and an alphanumeric identifier for the telephone number [e.g., the telephone owner's name], the method further comprising:

- d. editing the alphanumeric portion of the chosen telephone number record, wherein the editing better identifies the telephone number;

- e. editing the telephone number portion of the chosen telephone number record [see the rejections of claims 7-8 above]

Rossmann does not specifically teach that the editing makes the telephone number compatible with the communication terminal's telephone system and displayed in a standard format suitable for a format of the electronic telephone directory.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to edit the telephone number compatible with Rossmann's communication terminal (which is a cellular phone) and displayed in accordance with

the PIM or telephone book's format because by doing so the stored phone numbers can be made directly usable as they are stored.

18. As to claims 11 and 15, Rossmann does not specifically teach that displaying a telephone number record dialogue box; and receiving an instruction from a user identifying the one or more the telephone number records to capture.

However, Rossmann teaches that a menu of certain related operations could be provided in the browser application in a standard location [paragraph 90]. Since Rossmann's approach for choosing the telephone numbers can be accomplished by devising the related operations, it is obvious that using a dialogue box is a design option because the dialogue box provides well known interactive interface for the user.

19. As to claim 17, Rossmann teaches that the computer is the server hosting the Web page [paragraphs 85-87]. Rossmann does not specifically teach requesting a credit card number by the server, wherein the cost of a long distance telephone call to dispatch the message may be charged.

However, charging a communication terminal for the cost of long distance telephone call is well known in the art. For example, an ISP server may charge its client for connecting to the internet via long distance telephone calls. It would have been obvious to one of ordinary skill in the art at the time the invention was made to introduce a billing request, which can typically be paid through a credit card, when Rossmann's long distance call is involved for connecting Rossmann's terminal device and web page

host server because it is reasonable to pass whatever service charges onto the end users.

20. As to claims 18-19, Rossmann does not specifically teach marking the message with a password which is recorded on the browser with the destination address of the communications terminal, and determine that the message contains a telephone directory record, discarding the message if the message is not marked with a password.

However, it is well known in the art of secured communication by marking a message with a password.

It would have been obvious to one of ordinary skill in the art that Rossmann's message needs to be securely communicated to the terminal devices because by doing so it enhances the integrity of the local telephone directory by safe guarding the updating procedure with password detection.

21. As to claim 20, Rossmann does not specifically teach that by the communications terminal, the method further comprises: determining that the message contains a telephone directory record, providing notification that the message has arrived at the destination address.

However, it is obvious that, rather than stored locally, Rossmann's PIM or telephone directory could have been stored elsewhere in the network. Under such circumstances, it would have been obvious to one of ordinary skill in the art that Rossmann's extracted telephone numbers have to be sent to a remote network node

Art Unit: 2154

(such as a server) via a message containing telephone records, and therefore, notification of the message's arrival at the destination node is an obvious approach because it enables the sender to know whether the telephone numbers have been received, or otherwise a new attempt for sending the telephone numbers can be invoked.

22. As to claims 25, 34 and 36, since the features of these claims can also be found in claims 1, 11, 13, 16, 21 and 27, they are rejected for the same reasons set forth in the rejection of claims 1, 11, 13, 16, 21 and 27 above.

23. Applicant's arguments filed on 8/19/2005 for claims 1-39 have been fully considered but they are not deemed to be persuasive.

24. Applicant argues in the remarks that:

1. Rossmann does not teach every elements recited in the claims rejected under 102(e). Specifically, Rossmann does not teach using browser (the examiner cited "bookmark" as an example in the previous office action) to record the address of a telecommunication terminal having an electronic telephone directory because Rossmann discloses that the addresses with which it communicates are found within the web page being controlled, not within the browser
2. Applicant rebuts the Official Notice claimed in the previous office action because Applicant does not claim a simple updating of a database but rather

claims updating a telephone directory automatically and sending a notice warning only if a number already exists, which is not the same as what the examiner states as Official Notice.

25. Examiner respectfully disagrees with applicant's remarks:

1. As to point 1: It is noted that Rossmann does teach using a browser's bookmark for recording the address of a desired page [see paragraph 2]. It is further noted that although Rossmann discloses that the addresses for "related operations" and the database describing classified data elements are found within the web page being controlled, the desired "related operations" (or applications) are actually selected/invoked through the browser of the user's terminal [see Fig.7], wherein results of the operation may be saved at the same terminal [e.g., the user's PIM – see paragraphs 60-63]. Since a browser has access to any accessible file of a local file system (via, e.g., File-Save menu), it is equivalent to say that Rossmann's browser has pre-recorded all the files accessible from the file system. For at least this reason, it is asserted that the prior art of Rossmann reads on the claims because of the fact that Rossmann's "communications terminal" is co-located with the browser [note that the previously cited communication terminals 301 of Fig.3 is also the device the user uses to browse the networks].

2. As to point 2: It is noted that the word "automatically" is not found in the claims. It is further noted that in paragraphs 18-19 of the previous office action (on page 8) the

Art Unit: 2154

examiner uses the nominal warning-before-overwriting procedure to show applicability of the same procedure to update of Rossmann's telephone directory. This well-known procedure has to do with wiping out an old record, whether it is associated with a telephone directory or a database. An ordinary skill in the art would know how to adopt the same procedure in the update of a telephone directory because a telephone number may also be presented as a record in a database in general. The examiner further cites "integrity" as a main motivation for adopting such procedure in the update of Rossmann's telephone directory. The above Official Notices are maintained in this office action because Applicant only argues in the remarks that the scope of "updating a record in a file" or "updating a database" is simpler than the scope of "updating a telephone directory" and does not request for evidentiary support.

26. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

27. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2154

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Examiner note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday(8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)872-9306 for official communications; and

(571)273-3969 for status inquiries draft communication.

Art Unit: 2154

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

October 29, 2005

Wen-Tai Lin
10/29/05